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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09.576.057	05/23/2000	Joseph Chappell	07678-011004	3528

7590

03/08/2002

Paul T Clark
Calark & Elbing LLP
176 Federal Street
Boston, MA 02110

EXAMINER

NASHED, NASHAAT T

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 03/08/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/576,057

Applicant(s)
Chappell et al.

Examiner
Nashaat T. Nashed

Art Unit
1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 23, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|------------------------------------------------------------------------------|
| 15) <input type="checkbox"/> Notice of References Cited (PTO 892) | 18) <input type="checkbox"/> Interview Summary (PTO-413, Paper No.) |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO 948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO 152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO 1449, Paper No.) | 20) <input type="checkbox"/> Other |

Claims 1-14 are pending.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- | | |
|------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Group I | Claims 1-9, drawn to chimeric tobacco-hyoscyamus CH4 isoprenoid synthase, classified in Class 435, subclasses 232. |
| Group II | Claims 1-9, drawn to chimeric tobacco-hyoscyamus CH10 isoprenoid synthase, classified in Class 435, subclasses 232. |
| Group III | Claims 1-9, drawn to chimeric tobacco-hyoscyamus CH11 isoprenoid synthase, classified in Class 435, subclasses 232. |
| Group IV | Claims 1-9, drawn to chimeric tobacco-hyoscyamus CH12 isoprenoid synthase, classified in Class 435, subclasses 232. |
| Group V | Claims 1-9, drawn to chimeric tobacco-hyoscyamus CH13 isoprenoid synthase, classified in Class 435, subclasses 232. |
| Group VI | Claims 1-9, drawn to chimeric tobacco-hyoscyamus CH14 isoprenoid synthase, classified in Class 435, subclasses 232. |
| Group VII | Claims 10-14, drawn to nucleic acid encoding chimeric tobacco-hyoscyamus CH4 isoprenoid synthase, vector, and host cell, classified in Class 435, subclasses 410. |
| Group VIII | Claims 10-14, drawn to nucleic acid encoding chimeric tobacco-hyoscyamus CH10 isoprenoid synthase, vector, and host cell, classified in Class 435, subclasses 410. |
| Group IX | Claims 10-14, drawn to nucleic acid encoding chimeric tobacco-hyoscyamus CH11 isoprenoid synthase, vector, and host cell, classified in Class 435, subclasses 410. |
| Group X | Claims 10-14, drawn to nucleic acid encoding chimeric tobacco-hyoscyamus CH12 isoprenoid synthase, vector, and host cell, classified in Class 435, subclasses 410. |
| Group XI | Claims 10-14, drawn to nucleic acid encoding chimeric tobacco-hyoscyamus CH13 isoprenoid synthase, vector, and host cell, classified in Class 435, subclasses 410. |
| Group XII | Claims 10-14, drawn to nucleic acid encoding chimeric tobacco-hyoscyamus CH14 isoprenoid synthase, vector, and host cell, classified in Class 435, subclasses 410. |

The inventions are distinct, each from the other because of the following reasons:

The chimeric isoprenoid synthases of Groups I-VI, and the nucleic acids of Groups VII-XII are independent chemical entities and require different searches in the patent and non-patent literature. Claims drawn to method of making proteins using the recombinant DNA would be placed with the DNA of the appropriate Group because, although they have

acquired a separate status in the art as shown by their different classification, they do not constitute a burden to search them in addition to the DNA sequences.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

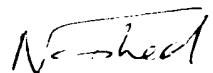
A telephone call was made to James D. DeCamp on March 4, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is (703) 305-6586. The examiner can normally be reached Monday, Tuesday, Thursday and Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on (703) 308-3804. The fax phone numbers for this Group are (703) 305-3014 and (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Nashaat T. Nashed, Ph. D.
Primary Examiner